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Paper 59

Filed: June 2, 2006

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2 Administrative Patent Judge
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10 UNITED STATES PATENT AND TRADEMARK OFFICE

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13 BEFORE THE BOARD OF PATENT APPEALS
14 AND INTERFERENCES
15 (Administrative Patent Judge Sally Gardner Lane)

16
17 DEB K. CHATTERJEE

18 Junior Party,
19 (Application 09/558,421),
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23 V.
24 STANLEY TABOR
25 and CHARLES RICHARDSON,
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28 Senior Party,
29 (Patent 5,614,365).
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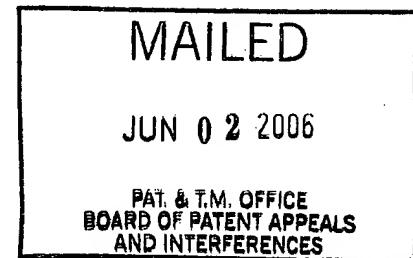
32 Patent Interference No. 105,292

33
34 Order - Miscellaneous - Bd.R 104(a)

35 A conference call was held on 25 May 2006 at approximately 3:15 pm.
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38 Participating in the call were:

- 39 1. George Quilling and Richard Warburg, counsel for Tabor,
40 2. Brian Del Buono, counsel for Chatterjee, and
41 3. Sally Gardner Lane, Administrative Patent Judge.



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1 A decision on non-priority motions has been entered in the interference. (Paper
2 57, "Decision"). In the Decision, Tabor's motion for judgment that the Chatterjee
3 claims are unpatentable for failing to comply with the written description and
4 enablement requirements of 35 USC 112, ¶ 1 was denied.

Deferred motions

6 Tabor has been authorized to file motions for judgment under 35 USC §§ 102(a)
7 and (e). However, the filing of these motions was deferred to the priority phase of the
8 interference. (Paper 27 at 2-3). These motions should be filed at the time set for Tabor
9 to file its priority motion, if any.¹ Oppositions and replies should be filed with the priority
10 motion and priority reply, respectively.

Correction of Tabor motions list

12 During the call, Tabor requested authorization to file a motion seeking judgment
13 that the Chatterjee claims are unpatentable under 35 USC §102(b) in view of patent
14 4,795,699. Tabor has not previously requested authorization to file such a motion. In
15 particular, Tabor did not place such a motion on its motions list.

16 Correction of a party's motions list will be authorized only "if entry would serve
17 the interests of justice." In addition, authorization to make the correction must be
18 sought promptly after the party becomes aware of the basis for the correction. Bd.R.
19 120(c). As noted in the Standing Order, "[t]he motions list is a tool for planning the
20 course of the proceeding, eliminating unnecessary costs and delay, and avoiding
21 abusive practices." (SO at ¶204).

¹ Tabor also requested to file a motion for priority on the basis that Chatterjee derived the invention from Tabor.

1 Tabor argues that it became aware of the basis for the correction only after
2 receiving the Decision denying its motion for judgment that the Chatterjee claims are
3 unpatentable for failing to comply with 35 USC 112, ¶1. According to Tabor, the
4 construction of Chatterjee's claims found in the Decision is such that the claims would
5 be unpatentable in view of patent 4,795,699. Tabor's argument is not persuasive. As
6 discussed during the call, Tabor was aware that the Board might not adopt the
7 construction of the Chatterjee claims that Tabor proposed in its motion for judgment.
8 Tabor could have sought authorization to file a motion that was contingent on the denial
9 of the motion for judgment on the basis of 112, ¶ 1, but Tabor did not. Allowing Tabor
10 to file the requested motion at this stage of interference is not consistent with securing a
11 just, speedy, and inexpensive resolution of the interference. Bd.R. 1(b).

12 Tabor points out that it argued, in its reply, that the claims, if interpreted as
13 Chatterjee urged in its opposition, would be anticipated by prior art. Tabor's reply is not
14 considered to be a request for correction of its motions list. For one thing, the Board
15 may not even consider the moving party's reply if, e.g., as happened here, the moving
16 party does not set forth a *prima facie* basis for relief. See *Nau v. Ohucida*
17 <http://www.uspto.gov/web/offices/dcom/bpai/its/104258.pdf>.

18 Moreover, Chatterjee's arguments, made during the conference call, that it would
19 be prejudiced if Tabor was allowed to file the motion at this time are persuasive.
20 Among other things, it was noted during the call that a party may make decisions about
21 how to proceed in an interference based on what motions its opponent plans to file,
22 particularly where an opponent plans to move for judgment that a party's claims are
23 unpatentable under 35 USC § 102(b). It would be unfair to Chatterjee to allow Tabor to

1 file the motion particularly since Tabor has not shown why it could not have requested
2 authorization to file the motion earlier in the proceedings.

3 Tabor has not shown that it would be in the interests of justice to allow it to
4 correct its motions list. Thus, Tabor is not authorized to file a motion for judgment that
5 the Chatterjee claims are unpatentable in view of the 4,795,699 patent. Tabor's
6 request is DENIED.

7 Should Tabor prevail in the interference:

8 (1) the Board may consider taking action under Bd.R. 127(c) and
9 (2) Tabor must inform the examiner of the 4,795,699 patent upon the resumption
10 of *ex parte* examination of its involved claims. 37 CFR 1.56.

11 *Extension of time*

12 According to Tabor it did not receive the Decision and the Order setting times for
13 taking action during the priority phase (Paper 58) until two weeks after it was entered
14 and after party Chatterjee had received the Decision and the Order. Tabor's request for
15 a two week extension of time is GRANTED. Accordingly, time period 18 is extended to
16 **19 January 2007.**

17 *Order*

18 Upon consideration of the record, it is

19 ORDERED that the time for Tabor to file any deferred motion for judgment
20 is Time Period 12;

21 FURTHER ORDERED that the time for Chatterjee to file its opposition to
22 any Tabor deferred motion for judgment is Time Period 13;

1 FURTHER ORDERED that the time for Tabor to file its reply to any
2 Chatterjee opposition to any Tabor deferred motion for judgment is Time Period 14;
3 FURTHER ORDERED that all evidence supporting any deferred motion,
4 opposition, and reply shall be filed with the Board at Time Period 18 only but shall be
5 served on the opponent with the deferred motion, opposition, and reply;

6 FURTHER ORDERED that the Tabor request to file a motion for judgment
7 that the Chatterjee claims are unpatentable over patent 4,795,699 is DENIED; and
8 FURTHER ORDERED that time period 18 is extended to

9 **19 January 2007.**

10 /Sally C. Medley/
11 SALLY C. MEDLEY
12 Administrative Patent Judge
13

14 cc (via First Class mail):
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